

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner continues to object to the incorporation by reference of the priority document. However, the Examiner indicates that “It is not required that the Applicants remove the incorporation by reference, just the portion of that reference to **essential** material” (emphasis in original). The incorporation by reference on page 1 of the present application reads:

This application claims benefit of Japanese Application No. 2000-237312 filed in Japan on August 4, 2000 the contents of which are incorporated by this reference.

Since the incorporation by reference does not refer to “essential” material, Applicants are confused as to the Examiner’s requirement. Although, Applicant believes that the incorporation by reference is proper, in order to advance prosecution, Applicant is willing to amend such incorporation by reference as suggested by the Examiner. Therefore, the Examiner is requested to contact the undersigned to discuss an appropriate amendment to the specification so as to obviate the objection.

In the Official Action, the Examiner rejects claims 1-3 and 9-15 under 35 U.S.C. § 102(b) as being clearly anticipated by JP 2000-060791. Furthermore, the Examiner rejects Claims 1-3, 8-12 and 14-15 under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,759,490 to Malchesky (hereinafter “Malchesky”) in view of U.S. Patent No. 6,361,751 to Hight, III (hereinafter “Hight”) and either U.S. Patent No. 4,739,729 to Monch (hereinafter “Monch”) or U.S. Patent No. 4,798,292 to Hauze (hereinafter “Hauze”). Additionally, the Examiner rejects claims 1-3, 8-12 and 14-15 under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,534,221 to Hillebrenner et al. (hereinafter “Hillebrenner”) in view of Hight and either Monch or Hauze. Furthermore, the

Examiner rejects claim 13 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Malchesky and Hight, and further in view of U.S. Patent No. 3,633,758 to Morse et al. (hereinafter "Morse"). Lastly, the Examiner rejects claim 13 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Hillebrenner and Hight, and further in view of Morse.

With regard to the rejection of claims 1-3 and 9-15 under 35 U.S.C. § 102(b), independent claims 1, 9, 10, 11 and 15 have been amended to clarify their distinguishing features.

The device of JP 2000-060791 has a groove for setting an insertion member of a length making it possible that the insertion member can be accommodated therein without being bent. Thus, the high-temperature high-pressure steam sterilization is not carried out while the insertion member is accommodated in a state in which it is bent.

In contrast, the endoscope container for high-pressure steam sterilization of claims 1, 10, 11 and 15 and the insertion member sheathing member for storage in a high-pressure sterilizing device of claim 9 patentably distinguish over JP 2000-060791 at least in that the insertion portion is in part bent. In such bent state, however, bending of a predetermined portion that is a distal 70 cm portion of the insertion member is restricted, thereby to prevent repeated bending from occurring in the predetermined portion when performing high-pressure steam sterilization.

Independent claims 1, 9-11 and 15 have been amended to clarify the above distinguishing features. Specifically, independent claims 1, 9-11 and 15 have been amended to recite that at least a part of the insertion member is bent when accommodating the endoscope. The clarifying amendment to independent claims 1, 9-11 and 15 are fully

supported in the original disclosure. Thus, no new matter has been entered into the disclosure by way of the present amendment.

With regard to the rejection of claims 1-3 and 9-15 under 35 U.S.C. § 102(b), a
endoscope container for high-pressure steam sterilization of claims 1, 10, 11 and 15 and an
insertion member sheathing member for storage in a high-pressure sterilizing device of claim
9 having the features discussed above is nowhere disclosed in JP 2000-060791. Since it has
been decided that “anticipation requires the presence in a single prior art reference, disclosure
of each and every element of the claimed invention, arranged as in the claim,”¹ independent
claims 1, 9-11 and 15 are not anticipated by JP 2000-060791. Accordingly, independent
claims 1, 9-11 and 15 patentably distinguish over JP 2000-060791 and are allowable. Claims
2, 3 and 12-14 being dependent upon claims 1 and 11, are thus at least allowable therewith.
Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 11-3
and 9-15 under 35 U.S.C. § 102(b).

With regard to the rejections of claims 1-3 and 8-15 under 35 U.S.C. § 103(a),
Applicants respectfully traverse the Examiner’s rejections for at least the reasons set forth
below.

Hight discloses a device in which a liquid medicine is stored and an endoscope
is immersed in it, thereby to disinfect the endoscope. That is to say, the container of Hight is
not the one which is to be put in a high-pressure sterilizing device. Thus, the size or shape of
the container itself is not subject to any restriction, i.e. the endoscope is not subject to
restriction when it is put in the container. Hence, the device of Hight is very different from

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

that recited in independent claims 1, 9-11 and 15 at least in that the insertion member has to be in part bent.

Hillebrenner discloses a device to sterilize an endoscope. However, in the device of Hillebrenner the insertion portion of the endoscope is merely rounded. In other words, the device of Hillebrenner is not the one to locate the endoscope while suppressing bending of the insertion portion as is recited in independent claims 1, 9-11 and 15.

Malchesky discloses a device to sterilize a catheter. However, Malchesky does not disclose or suggest holding so as to relax the bending of a distal 70 cm of the insertion portion.

Mose discloses a rack for holding a catheter in a straight status or in a bent status. However, in Mose, almost the entire catheter except the proximal side thereof is held in a bent state. Hence, Mose also does not disclose or suggest holding so as to relax the bending of a distal 70 cm of the insertion portion.

Hauze discloses a container that can be arrayed and accommodated in accordance with the configuration of the operation instruments, which is thus different from that recited in claims 1, 9-11 and 15 to store while having a portion of the flexible insertion member bent.

Thus, independent claims 1, 9-11 and 15 are not rendered obvious by the cited references because neither the Hight patent, the Hillebrenner patent, the Malchesky patent, the Mose patent nor the Hauze patent whether taken alone or in combination, teach or suggest an endoscope container for high-pressure steam sterilization of claims 1, 10, 11 and 15 or an insertion member sheathing member for storage in a high-pressure sterilizing device of claim 9 having the features discussed above. Accordingly, claims 1, 9-11 and 15 patentably

distinguish over the prior art and are allowable. Claims 2, 3, 8 and 12-14, being dependent upon claim 1 are thus allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-3 and 8-15 under 35 U.S.C. § 103(a).

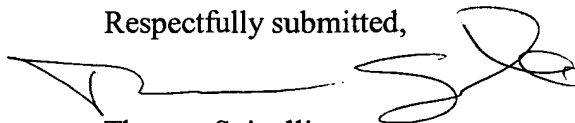
Furthermore, the Examiner has ignored Applicant's previous arguments that there is no motivation or suggestion to combine either Malchesky or Hillebrenner with Hight because Hight teaches away from the use of basin type apparatus for endoscope sterilization and those skilled in the art would not be motivated to combine the teachings thereof with the basin type apparatus in either Malchesky or Hillebrenner. All of the remaining rejections contain a combination of either Malchesky or Hillebrenner with Hight. Therefore, Applicant incorporates the arguments from the previous response with regard to such lack of motivation or suggestion to combine the references, reiterate such arguments and request that the Examiner withdraw the rejections based on such argument or provide a response thereto.

Lastly, in the Official Action, the Examiner provisionally rejects claims 1-3 and 9-15 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1 and 25-34 of co-pending Application No. 09/894,659.

In response, in order to advance prosecution, Applicant files herewith a terminal disclaimer disclaiming any portion of the term of a U.S. patent which eventuates from the present application which extends beyond the term of co-pending Application No. 09/894,659. Accordingly, the Examiner is respectfully requested to withdraw the rejection of claims 1-3 and 9-15 under the judicially created doctrine of obviousness-type double patenting.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Thomas Spinelli', with a stylized, looping flourish at the end.

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Encl. (Terminal Disclaimer)